

Application No.: 10/653,601

Docket No.: 00-VE20.59DIV1

REMARKS

This amendment is intended to be fully responsive to the Office Action having a mailing date of August 24, 2005, wherein claims 28-34 are rejected. Independent claims 28 and 30 have been amended and claims 29 and 31 have been canceled. Applicants thank the Examiner for the telephonic interview conducted on November 3, 2005, in which certain claim rejections set forth in the Office Action were discussed although no agreement was reached.

No new matter has been added by the amendments herein. Claims 28-34 are currently pending and are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly patentable over claims 1-4 of U.S. Patent No. 6,614,880 in view of U.S. Patent No. 6,389,125 issued to Ubowski. Claims 28, 30 and 33-34 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,201,854 issued to Avitsur et al. Claims 29, 31, and 32 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Avitsur et al. in view of Ubowski.

Double Patenting

Claims 28-34 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-4 of U.S. Patent No. 6,514,880 in view of U.S. Patent No. 6,389,125.

Pursuant to 37 CFR 1.321(c), Applicants hereby provide a terminal disclaimer to overcome the above rejection in view of the fact that U.S. Patent No. 6,514,880 and the present application (Serial No.: 10/653,601) are commonly owned. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 28, 30 and 33-34 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Avitsur et al. (6,201,854). Applicants respectfully traverse this rejection.

Amended independent claim 28 recites an automated telephone test apparatus that comprises, among other things, a test circuit means operative to

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"receive DTMF signals indicative of a telephone number corresponding to said telephone line from said line identification facility at said central office to which said dialing signals were applied; decode said received DTMF signals; retrieve said stored assignment data from said memory; compare said telephone number indicated by said retrieved assignment data with said telephone number indicated by said received and decoded DTMF signal; and indicate whether said telephone line tested was the intended subject of the test assignment." (*Emphasis added.*)

Amended independent claim 30 recites similar limitations.

As admitted on page 6 of the Office Action, Avitsur et al. does not teach a DTMF decoder to decode the received line number data signals. Claims 28 and 30 now explicitly require the ability to "decode said received DTMF signals...". Accordingly, the Examiner agrees that Avitsur et al. does not anticipate independent claims 28 and 30 as amended, as well as their respective dependent claims. Therefore, Applicants respectfully request that the section 102 rejection of claims 28, 30 and 33-34 be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitsur et al. (6,201,854) in view of Ubowski (6,389,125). Applicants respectfully traverse this rejection.

Independent claim 32 recites the following.

A method of identifying a telephone line, comprising the steps of:

receiving at a central office dialing signals transmitted via a telephone line connected to the central office; in response to receiving said dialing signals, generating at said central office DTMF signals indicative of a telephone number which corresponds to said telephone line on which said dialing signals were transmitted, and transmitting on said telephone line said DTMF signals generated at said central office. (*Emphasis added.*)

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Amended independent claims 28 and 30 include limitations incorporated from cancelled claims 29 and 31 that are similar to the foregoing limitations emphasized in claim 32. Applicants submit that the combination of the cited references do not meet all the claim limitations nor is there a motivation to combine their teachings.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facia* obviousness as follows: "To establish a *prima facia* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." The initial burden in presenting a *prima facie* case of obviousness is on the examiner. *In re Oetiker*, 977 F.2d 1443, 1443 (Fed. Cir. 1992). Here, the Examiner has failed to 1) show a combination of art that meets all claim limitations, and 2) show a motivation to combine the teachings of the references.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. When obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some "suggestion, teaching, or motivation" that would have lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references." *Dembiczak*, 175 F.3d at 999; see also *Ruiz*, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." *Dembiczak*, 175 F.3d at 999. "Therefore, we have consistently held that a person of

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ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed." *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed.Cir. 2000).

Avitsur et al. teaches a testing environment and a method for telephone number identification and/or verification. As noted above, the Examiner admits that Avitsur et al. does not teach an automated telephone test apparatus that includes a DTMF decoder to decode the received line number data signals (DTMF signals) received from the central office. Avitsur et al. teaches no more than receiving a voice announcement from a central office switch that includes the telephone number of the telephone line to be tested wherein the voice announcement may be converted to text to determine the contents of the message. (See col. 6, lns. 14-17.) Avitsur et al. does not teach or suggest generating DTMF signals at the central office that are indicative of a telephone number of the telephone line to be tested, much less does Avitsur et al. teach or suggest thereafter transmitting those signals on the tested telephone line.

Ubowski, which is alleged to compensate for the deficiencies of Avitsur et al., teaches a telephone system wherein a plurality of telephone devices are capable of receiving call related telephone information, but only one of the devices is designated as a master device responsible for acknowledging receipt of call related information to the central office, and for controlling transfer of the received data to and between each of the other devices over a common telephone line. (See col. 3, lns. 44-53) Although Ubowski discloses using DTMF signaling to transfer information between the master and slave devices, it does not teach or suggest using DTMF signaling from a central office to identify a telephone line in response to receiving dialing signals on that telephone line at the central office. Accordingly, even if the alleged combination of Avitsur et al. and Ubowski included using DTMF signaling from a central office to identify a telephone line in response to receiving dialing signals on that telephone line at the central office, which it does not, Applicants submit that there is no motivation to combine the teachings of the prior art of record.

Significantly, the Office Action (see pg. 6) provides no motivation from any prior art to combine Avitsur et al. and Ubowski, and, indeed, no such motivation was present. Therefore, the section 103 rejection should be withdrawn for either of the two independent reasons that 1) the combination of the prior art of record does not teach all of the claims limitations and 2) there is no suggestion, teaching, or motivation to combine the teachings of the prior art of record. Thus, the cited references do not provide the basis for an obviousness rejection. Accordingly,

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each of the independent claims 28, 30 and 32 is in condition for allowance. Applicants respectfully request that this rejection be withdrawn and that all claims be passed to issue.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 07-2347, under Order No. 00-VE20.59DIV1 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: December 21, 2005

Respectfully submitted,

By _____

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